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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/501,923

07/06/2005

Masayoshi Kawamoto

7379

7533

39196

7590

04/28/2009

SHLESINGER, ARKWRIGHT & GARVEY LLP  
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ALEXANDRIA, VA 22314

EXAMINER

SHAIKH, MOHAMMAD Z

ART UNIT

PAPER NUMBER

3696

MAIL DATE

DELIVERY MODE

04/28/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/501,923	<b>Applicant(s)</b> KAWAMOTO ET AL.	
	<b>Examiner</b> MOHAMMAD Z. SHAIKH	<b>Art Unit</b> 3696	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 8-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                        |                                                                   |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>04/13/05</u> .                                                | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Claim Rejections- 35 U.S.C § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 8-11 are being rejected under 35 U.S.C 103(a) as being unpatentable over US Patent 6,588,673 to Chan et al, herein Chan in view of US Patent 6,880,084 to Brittenham et al, herein Brittenham.

Regarding claim 8, Chan discloses a method of creating an IC card that is carried by an IC card creation entrusted company server, wherein: said IC card creation entrusted company server previously registers advance registration information data which include at least one template information in relation to at least one application stored in the IC card (column 3: lines 3-11); said IC card creation entrusted company server receiving IC card setting data composed of card basic information data including individual information and IC card unique information assigning data including at least one application assigning information (column 3: lines 17-22). However Chan does not disclose said IC card creation entrusted company server taking out said template information which is previously registered with respect to each application, in accordance with said application, in accordance with said application assigning information which is included in said IC card setting data. Brittenham discloses said IC card creation entrusted company server taking out said template information which is

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previously registered with respect to each application, in accordance with said application assigning information which is included in said IC card setting data (column 32: lines 27-36). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Chan's invention to include said IC card creation entrusted company server taking out said template information which is previously registered with respect to each application, in accordance with said application assigning information which is included in said IC card setting data. One of ordinary skill in the art would have been motivated to include said IC card creation entrusted company server taking out said template information which is previously registered with respect to each application, in accordance with said application assigning information which is included in said IC card setting data in order to ensure that the customer has the options of removing the applications from their ic-card which they no longer need. Chan further discloses assigning information which is included in said IC card setting data; said IC card creation entrusted company server combining said card basic information data with the taken template information to create loading data with respect to each application (Fig 2A: 210,220,230); and said IC card creation entrusted company server merging the loading data of each application to produce the IC card creation data (Fig 2B: 240,250).

Regarding claim 9, Chan discloses a method of creating an IC card that is carried by an IC card creation entrusted company server and an IC card creation company server, wherein: said IC card creation entrusted company server previously registers advance registration information data which include at least one template information in

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relation to at least one application stored in the IC card (column 3: lines 3-11); said IC card creation entrusted company server receiving IC card setting data composed of card basic information data including individual information and IC card unique information assigning data including at least one application assigning information (column 3: lines 17-22). However Chan does not disclose said IC card creation entrusted company server taking out said template information which is previously registered with respect to each application, in accordance with said application assigning information which is included in said IC card setting data. Brittenham discloses said IC card creation entrusted company server taking out said template information which is previously registered with respect to each application, in accordance with said application assigning information which is included in said IC card setting data (column 32, lines 27-36). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Chan's invention to include said IC card creation entrusted company server taking out said template information which is previously registered with respect to each application, in accordance with said application assigning information which is included in said IC card setting data. One of ordinary skill in the art would have been motivated to include said IC card creation entrusted company server taking out said template information which is previously registered with respect to each application, in accordance with said application assigning information which is included in said IC card setting data in order to ensure that the customer has the options of removing the applications from their ic-card which they no longer need. Chan further discloses said IC card creation entrusted company

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server combining said card basic information data with the taken template information to create loading data with respect to each application; said IC card creation entrusted company server merging the loading data of each application to produce the IC card creation data; said IC card creation entrusted company server transmitting said IC card creation data to said IC card creation company server; and said IC card creation company server loading said IC card creation data to an chip of the IC card to create the IC card (column 4: lines 11-23; column 8: lines 50-67; column 9: lines 1-9).

Claims 10-11 disclose the same limitations as claim 9.

### **CONCLUSION**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MOHAMMAD Z. SHAIKH whose telephone number is (571)270-3444. The examiner can normally be reached on Monday-Friday (7:30-5); alt Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Dixon can be reached on 571-272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. Z. S./  
Examiner, Art Unit 3696  
4/16/2009

Mohammad Z Shaikh  
Examiner  
Art Unit 3696

/Daniel S Felten/  
Primary Examiner, Art Unit 3696